

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGEHIRO ARAI

Appeal No. 96-1603
Application 08/057,989¹

ON BRIEF

Before ABRAMS, NASE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 11-20. Claims 2-10 are allowed.

Appellant's invention is a table feeder. Claim 1 is exemplary of the subject matter on appeal and recites:

1. A table feeder apparatus comprising: a feed screw supported rotatably on a base; a motor for rotating the feed screw about its axis; a feed nut threadedly engaged with the

¹ Application for patent filed May 5, 1993.

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feed screw; a block mounted integrally with the feed nut; a table supported by the block for movement along an axial direction of the feed screw; and a slide mechanism disposed between the block and the table, the slide mechanism being slidable in at least one of a horizontal direction and a vertical direction along a plane transverse to the axial direction of the feed screw.

THE REFERENCES

The following references were relied on by the examiner to support the rejections:

Blatt	4,988,261	Jan. 29, 1991
Kato	5,054,991	Oct. 8, 1991

THE REJECTIONS

Claims 13 and 15-20 stand rejected under 35 U.S.C. § 112, first paragraph because the specification as originally filed, does not provide support for the invention as claimed.

Claims 1, 11 and 15-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kato.

Claims 1, 11, 12 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blatt.

Rather than reiterate the respective positions of the examiner and the appellant in support of their respective positions, reference is made to the examiner's answer (Paper

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No. 13) and the appellant's brief (Paper No. 12) and reply
brief

(Paper No 15) for the full exposition thereof.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior applied by the examiner, and the respective positions advanced by the appellant and the examiner. As a consequence of this review, we have made the determinations which follow.

We turn initially to the examiner's rejection of claims 13 and 15-20 under 35 U.S.C. § 112, first paragraph. The examiner states that there is no support in the original disclosure for the recitation in claim 13 of a hydrostatic bearing, and thus relies on the "written description" requirement of 35 U.S.C. 112, first paragraph. The examiner also states that it is unclear how the hydrostatic bearing recited in claim 13 is constructed and how the slides are

force absorbing means as recited by claim 15 and thus relies on the enablement requirement of 35 U.S.C. § 112.

We initially note that the written description requirement is separate from the enablement requirement. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, sub nom Wilder v. Mossinghoff, 469 U.S. 1209 (1985).

The purpose of the written description requirement is to ensure that the inventor had possession of the invention as of the filing date. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In deciding whether or not the written description requirement has been satisfied, the content of the drawings, may be considered. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Appellant, while recognizing that the originally filed specification refers to a "static" rather than "hydrostatic" bearing, asserts that it is self-evident from Figure 2 that bearing 15 is a hydrostatic bearing. According to appellant, ports, which are shown but not numbered, communicate with grooves which are also shown but not numbered. Appellant concludes that one of ordinary skill in the art would note by

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looking at Figure 2 that bearing 15 is a hydrostatic bearing.

The examiner responds:

Appellant would have the Board believe that the spaces around elements 15, 16, 17 in his figure 2 are indicative of ports and grooves for a hydrostatic bearing. The examiner is of the opinion that the spaces in figure 2 are similar to the spaces around elements 10, 12, 13, 14 in appellant's figure 1 which merely represent spaces between parts. Even if one concluded that the spaces in figure 2 were ports and grooves, they would further conclude that these ports and grooves were lubrication structures for grease and not for hydrostatic bearings since no additional structure is present to provide fluid for a hydrostatic arrangement, i.e., no sump, pump or connecting lines are present. [Examiner Answer at page 6]

We agree with the analysis of the examiner. Appellant argues that those of ordinary skill in the art would know by looking at Figure 2, that bearing 15 is a hydrostatic bearing. Filed along with the reply brief, is a document of unknown origin, entitled "Outline of Mechanical Structure" which depicts hydrostatic pressure pockets on a worktable. We initially note that the exhibit was not accompanied by a

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showing of good and sufficient reason why it was not earlier presented, as required by 37 CFR § 1.195. In addition, although the exhibit labels certain elements "hydrostatic pressure pockets", it does not show that a person skilled in the art would recognize the elements as "hydrostatic pressure pockets" without the label. As such, the exhibit is not evidence that a person skilled in the art would know that bearing 15 is a hydrostatic bearing. In view of the foregoing, it is our view that there is no written description support for the recitation of "hydrostatic" bearing in claim 13.

With regard to the question of enablement, it is well settled that the examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 370 (CCPA 1971); In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Once this is done, the burden shifts to the appellant to rebut this conclusion by presenting evidence to prove that the disclosure is enabling. Id. At 1561. In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973); In re Doyle, 482 F.2d 1385, 1392, 179 USPQ

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227, 232 (CCPA 1973), cert. denied, sub nom. Doyle v. Comm'r Pats., 416 U.S. 935 (1974). Additionally, as the court in In re Gaubert, 524 F.2d 1222, 1226, 187 USPQ 664, 667 (CCPA 1975) stated:

[t]o satisfy § 112, the specification disclosure must be sufficiently complete to enable one of ordinary skill in the art to make the invention without undue experimentation, although the need for a minimum amount of experimentation is not fatal. . . . Enablement is the criterion, and every detail need not be set forth in the written specification if the skill in the art is such that the disclosure enables one to make the invention.

The determination of what constitute undue experimentation in a given case requires the application of a standard of reasonableness, having regard for the nature of the invention and the state of the art. See In re Wands 858 F.2d 731, 736-737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

In our view, the examiner has not met his burden of producing reasons to show that a person would not know how to operate a common element such as a hydrostatic bearing. In

regard to how the slides absorb force, we are of the opinion that the specification in explaining that the slides absorb the leftward and rightward deviation of the block is sufficiently complete to enable a person of ordinary skill in this art to make this invention.

In view of the foregoing we will sustain the examiner's rejection under 35 U.S.C. § 112, first paragraph as it is directed to claim 13 but will not sustain the rejection as it directed to claims 15-20.

We turn next to the examiner's rejection under 35 U.S.C. § 102(b) of claims 1, 11 and 15-18 as anticipated by Kato. Kato discloses a feed screw 12 mounted on base 11 and a motor 13 for rotating the feed screw about its axis. There is also disclosed a feed nut and a frame or block 15 mounted integrally to the nut. There is a table 2 mounted for movement along an axial direction of the feed screw. There is a slide mechanism 16, 17 disposed between the block 15 and the table 2. The slide mechanism is slidable in a vertical direction along a plane transverse to the axial direction of the feed screw. Kato discloses each and every element of

claim 1, and thus we will sustain the examiner's rejection of this claim under 35 U.S.C. § 102(b).

Appellant argues that Kato does not disclose a block mounted integrally with the feed nut and a table supported by the block for movement along an axial direction of the feed screw.

However, as admitted by appellant in the brief at page 15, frame or block 15 is mounted integrally with the feed nut. In addition, as depicted in Figure 1, frame or block 15 clearly supports table 2 for movement along an axial direction of the feed screw.

Appellant also argues that the configuration of the threaded shafts 12, 16 and guide shafts 14, 17 represents the conventional prior art feeding apparatus in which there is no specific slide mechanism disposed between feed screw 12 and the frame or block 15. The appellant concludes that since screw 12 and frame or block 15 are connected to each other integrally, the table is directly influenced by angular deflection of the feed nut in a direction transverse to the feed axis of the feed screw 12. This argument is not persuasive because in the examiner's analysis, the frame 15 is

the block recited in claim 1 and the table 2 is the table recited in claim 1. There is clearly a slide mechanism 16, 17 between the block 15 and the table 2. As there is a sliding mechanism 16, 17 between the block or frame 15 and the table 2 Kato discloses these specific elements of claim 1. In view of the foregoing, we will sustain the examiner's rejection of claim 1.

We will also sustain the examiner's rejection of claim 11 as appellant has not argued the separate patentability of this claim. See In re Nielson 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987).

We turn next to claim 15 which recites in pertinent part:

. . . .force absorbing means disposed between the table and the support means for absorbing the force applied to the support means to prevent the applied force from being transmitted to the table.

The examiner states:

. . . the slide mechanism 16, 17 is synonymous with applicants' force absorbing means since the nut and screw drive for the slide mechanism would permit movement transverse to screw 12 when screw 12 were activated. This movement would be present until the nut

and screw drive for slide
mechanism 16, 17 took up normal
slack between its nut and screw.
[Examiner's Answer at page 5]

In essence, it is the examiner's position that the slide mechanism 16, 17 of Kato inherently absorbs force applied to the support means to prevent the applied force from being transmitted to the table.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. V. Garlock, Inc., 721 F.2d 1540, 1555, 220 USPQ 303, 313 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Wilding, 535 F.2d 631, 635, 190 USPQ 59, 63 (CCPA 1976); Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939).

The examiner in the instant case has provided no basis in fact or technical reasoning for concluding that the nut and screw arrangement of Kato absorbs forces applied to the

support or that it prevents applied force from being transmitted to the table and as such in our view the examiner has not met his burden. Therefore, we will not sustain the rejection as it is directed to claim 15 or claims 16-18 dependant therefrom.

We turn finally to the examiner's rejection of claims 1, 11, 12 and 14 under 35 U.S.C. § 102(b) as anticipated by Blatt. We find that Blatt discloses a work holder platform or table 40 which includes a feed screw 24 and a motor 27 for rotating the feed screw 24. A feed nut 26 is threadably engaged with the feed screw 24 (See Fig. 4). A block 30 is fixedly mounted to the feed nut 26 (Col. 4, lines 46-47). There is also disclosed a slide mechanism (38,42) between block 30 and table 40 (Col 5, lines 9-11). This slide mechanism is slidable in a horizontal direction transverse to the axial direction of the feed screw (Col. 6, lines 8-12).

In view of these findings, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Blatt.

Appellant argues that Blatt does not disclose a block mounted integrally with the feed nut. However, the appellant

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refers to base plate 40 as the block rather than block 30. As stated above, we find that Blatt does disclose a block (block 30) mounted integrally with the feed nut.

We agree with the examiner that element 44 is a fitting member as broadly claimed and as such, we will sustain the examiner's rejection of claim 11. We shall also sustain this rejection as it is directed to dependent claims 12 and 14 since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with the independent claim 11 from which they depend. See Nielson, 816 F.2d at 1567, 2 USPQ2d at 1525.

In summary:

The examiner's rejection of claims 13 under 35 U.S.C. § 112, first paragraph is sustained.

The examiner's rejection of claims 15-20 under 35 U.S.C. § 112, first paragraph is not sustained.

The examiner's rejection of claims 1 and 11 under 35 U.S.C. § 102(b) as anticipated by Kato is sustained.

The examiner's rejection of claims 15-18 under 35 U.S.C. § 102(b) as anticipated by Kato is not sustained.

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The examiner's reaction of claims 1, 11, 12 and 14 under
35 U.S.C. § 102(b) as being anticipated by Blatt is sustained.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

	NEAL E. ABRAMS)	
	Administrative Patent Judge)	
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	JEFFREY V. NASE)	BOARD OF
PATENT	Administrative Patent Judge)	

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MURRIEL E. CRAWFORD
Administrative Patent Judge

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